REMARKS

Claims 1, 4, 8-10, 12, 15, and 18-20 have been amended for clarification purposes only, and do not present new matter or warrant a new search. Therefore, claims 1-20 are currently pending in the case. Further examination and reconsideration of the presently claimed application are hereby respectfully requested.

Section 103 Rejections

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,727,918 to Nason (hereinafter "Nason") in view of a publication written by Amy Fowler, entitled "Mixing Heavy and Light Components" (hereinafter "Fowler").

To establish a case of *prima facie* obviousness of a claimed invention, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, there must be a reasonable expectation of success. As stated in MPEP 2143.01, the fact that references can be hypothetically combined or modified is not sufficient to establish a *prima facie* case of obviousness. *See In re Mills*, 916 F.2d. 680 (Fed. Cir. 1990). Finally, the prior art references must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d. 981 (CCPA 1974); MPEP 2143.03 (emphasis added). Specifically, "all words in a claim must be considered when judging the patentability of that claim against the prior art." *In re Wilson* 424 F.2d. 1382 (CCPA 1970). Using these standards, Applicants contend that even if the cited art is combined, the hypothetically combined cited art still fails to teach or suggest all features of the currently pending claims. Several distinctive features of the present invention are set forth in more detail below.

Nason and Fowler each fail, in their own right and in combination, to provide teaching, suggestion or motivation for a display system (claim 1), computer-readable storage device (claim 18) or method (claim 10) for: (i) displaying a first image upon the display during a first time, where the first image is independent of the operating system, (ii) displaying a second image upon the display during a second time, where the second image is dependent of the operating system, and (iii) where the first and second images are substantially identical (i.e., have the same look and feel). Amended independent claim 1 recites in part:

A display system, comprising ... a processor coupled between the display and the graphical user interface and adapted to operate from a windows-based operating system for executing a software component during runtime of an application program, wherein the executed software component generates a first image upon the display independent of code within the operating system during a first time and, during a second time, emulates code that, when executed by the processor, generates a second image upon the display dependent on code within the operating system, and wherein the first and second images are substantially identical.

Claim 18 recites a similar limitation. In claim 10, a method is provided for displaying an image with a first, platform-specific interface (e.g., an AWT-type API), and at some point in time, replacing the first interface with a second, platform-independent interface (e.g., a Swing-type API) for re-displaying the image with the same look and feel.

Thus, each independent claim of the present application not only describes the use of two different APIs for generating images, but more importantly, describes a means for displaying an image with a platform-independent interface during a first time, and displaying a substantially identical image with a platform-specific interface during a second time. For example, the presently claimed case teaches that, when an application program is run during the first time, a button may be displayed using a Swing-type API. At some point in time, the Swing-type API may be replaced with an AWT-type API, such that when the application program is run during the second time, the button is re-displayed with the AWT-type API. See, e.g., Specification, page 11, line 28 to page 13, line 22.

Contrary to the teachings of the presently claimed case, Nason discloses "computer software [for displaying] one or more user interfaces that can coexist with a native user interface provided by the computer system." (Nason, column 1, lines 17-19, emphasis added). More specifically, Nason provides "a technique for controlling allocation and content of display space among one or more user interfaces, operating systems or applications permitting an application or parallel graphical user interface (GUI) to operate outside the desktop, the area designed for display of the native operating system interface and it's associated applications." (Nason, column 2, lines 40-46). For example, Nason states that the "operating system user interface (the native GUI) may be scaled and/or moved to a specific area of the display permitting a parallel (or complementary) GUI to operate in the open area." (Nason, column 2, lines 50-54). Therefore, the teachings of Nason provide a means for displaying one or more parallel (or complementary) GUIs outside of the primary desktop display area, so that the complementary GUIs may be displayed along with (i.e., may coexist with) the native GUI. See, e.g., Nason, column 3, lines 39-51 and column 4, lines 4-11.

SN 09/870,624 Response to Office Action mailed August 13, 2004   Page 7 of 10

PAGE 7/10 * RCVD AT 11/8/2004 3:56:28 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/1 * DNIS:8729306 * CSID:5127031250 * DURATION (mm-ss):05-50

In regard to claims 1, 10 and 18, statements in the Office Action suggest that Nason teaches a system and method for "implementing two different APIs, one independent of OS, one dependent on OS, to generate images..." (*See*, e.g., Office Action, page 2). Applicants contend that, while generating images with two different APIs is part of what is claimed, claims 1, 10 and 18 are not limited to such a feature. Instead, and as described above, claims 1 and 10 describe a system and method for displaying an image with a platform-independent interface during a first time, and displaying the same image (i.e., a substantially identical image, or an image with the same look and feel) with a platform-dependent interface during a second time. It is noted that "all words in a claim must be considered when judging the patentability of that claim against the prior art." *In re Wilson* 424 F.2d. 1382 (CCPA 1970).

Though Nason may disclose the use of two different APIs, Nason definitely fails to teach or suggest that an image (within, e.g., a complementary GUI) may be displayed with a platform-independent interface during a first time, while during a second time, the same image may be displayed with a platform-specific interface. As such, Nason fails to teach or suggest all limitations of present claims 1, 10 and 18.

Nason also fails to provide teaching or suggestion for an application program that generates an OS-dependent image during a first time and an OS-independent image during a second time, where the first and second images are substantially identical and the second image is adapted to overwrite the first image upon a display screen, as further recited in present claim 18. Instead, Nason provides a technique for displaying a complementary or parallel GUI along with the native user interface by positioning the complementary GUI in the open areas (referred to as "overscan areas") outside of the primary desktop display area. Nason clearly fails to provide a technique for replacing or overwriting OS-dependent images with OS-independent images, and therefore, cannot be relied upon to teach or suggest the additional limitations recited in present claim 18.

Fowler also discloses the use of two different APIs. For example, Fowler discloses some of the many differences between, and problems associated with, mixing heavyweight AWT components with lightweight Swing components. Like Nason, however, Fowler simply fails to provide any teaching or suggestion for displaying an image with a platform-independent interface during a first time, and displaying the same image with a platform-specific interface during a second time. Instead, Fowler attempts to simultaneously display separate and distinct images (e.g., the two label images on page 4, or the button and combo box images on page 7), which are generated with platform-independent (Swing) and platform-specific (AWT) APIs. In other words, the separate and distinct images disclosed by Fowler are

displayed at the same time – not a first time and a second time, as presently claimed. Furthermore, the separate and distinct images of Fowler cannot be considered the same image, since more than one image is displayed at a time. (Recall: the two label images on page 4 and the button and combo box images on page 7 of Fowler.) Moreover, the platform-independent Swing images of Fowler cannot successfully be used to overwrite platform-dependent AWT images (*See*, e.g., page 4 of Fowler including *Guideline No. 1*). As such, Fowler fails to teach or suggest all limitations of present claims 1, 10 and 18.

Because Fowler fails to provide teaching or suggestion for the above-mentioned limitation, the teachings of Fowler cannot be combined with those of Nason to overcome the deficiencies therein. In other words, the combined teachings of Nason and Fowler do not provide teaching or suggestion for the above-mentioned limitations of the present claims when all words recited in those claims are rightfully considered.

Furthermore, the teachings of Nason and Fowler cannot be modified to include the above-mentioned limitations of present claims 1, 10 and 18, since Fowler and Nason each fail to even suggest a desirability for doing so. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination [or modification]. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01.

In fact, Fowler appears to teach away from displaying an image with the AWT API during a first time, and displaying the same image with the Swing API during a second time. For example, due to the inherent benefits of Swing and the many problems encountered when mixing AWT and Swing, Fowler recommends that Swing components be used exclusively, and that AWT and Swing components be mixed only when the desired Swing component is not available (*See*, e.g., Fowler, page 2). Since Fowler discourages the use of AWT components, there is no motivation to modify the teachings of Fowler for displaying an image with an AWT component during a first time, and displaying the same image with a Swing component during a second time (or vice versa). It is noted that a *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997); MPEP 2144.05 (III).

For at least the reasons set forth above, Applicants assert that independent claims 1, 10, and 18, as well as claims dependent therefrom, are patentable over the cited art. Accordingly, Applicants respectfully request removal of this rejection.

SN 09/870,624 Response to Office Action mailed August 13, 2004   Page 9 of 10

PAGE 9/10 * RCVD AT 11/8/2004 3:56:28 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/1 * DNIS:8729306 * CSID:5127031250 * DURATION (mm-ss):05-50
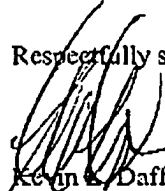
On page 10 of the Office Action, the Examiner states that "[t]he prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure." However, Nason appears to be the only reference cited on form PTO-892. As such, Applicants respectfully request that the Examiner submit a new PTO-892 form with any prior art intended for the record, or if there is no additional art, to strike the statement on page 10 from the record.

CONCLUSION

This response constitutes a complete response to all issues raised in the Office Action mailed August 13, 2004. In view of the remarks traversing rejections, Applicants assert that pending claims 1-20 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 50-3268/5468-08100.

Respectfully submitted,

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